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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,260	02/12/2004	Zachary Adam Garbow	ROC920030353US1	5414
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EXAMINER				
POLLACK, MELVIN H				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/777,260

Applicant(s)

GARROW, ZACHARY ADAM

Examiner

MELVIN H. POLLACK

Art Unit

2445

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: see attached office action

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-6 and 21-23 have been considered but are moot in view of the new ground(s) of rejection.
2. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).
3. In response to applicant's argument that no particular piece of art matches claim 1, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).
4. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that you can see the PDA screen in the "closed" position) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The limitations that "the PDA rotates via the second hinge between a second closed position atop the lid portion of the computer" such that "the screen of the PDA is not viewable simultaneously

with the computer display” does not foreclose the situation wherein neither the PDA screen nor the computer screen is not visible.

5. Of primary issue is what Ramakesavan teaches in regards to the connection of the PDA to the laptop computer (Figs. 4 – 6). The examiner concedes that the art could be better written and labeled, but insists that one of ordinary skill in the art could interpret Paras. 32-34 in the described manner. Even presuming that Fig. 5A shows simply two parts of a PDA connected by a hinge, such an interpretation still colors the enablement of Fig. 6, wherein a detachable PDA is coupled to a screen. Given that it already has a hinge, this would be an obvious and motivated method of attaching.

6. Furthermore, the test is what one of ordinary skill in the art would see as possible upon combining the art. Singleton and Ramakesavan both disclose the ability to see both screens simultaneously when the laptop is open. Ramakesavan teaches the usage of multiple hinges. Huber teaches a method wherein the screens are simultaneously viewable in the open position (laptop in slot 110) and wherein only the PDA screen is viewable in the closed position (615). The test, as described above, is not to find the perfect hinge, but to recognize that the art provides such a significant number of embodiments that the structural combination in question would be obvious to one of ordinary skill in the art.

7. For the sole purpose of advancing prosecution, and in light of Ramakesavan's murkiness on the issue, the art rejection has been modified to reflect the newly amended claims and to clarify the examiner's combination.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 4, 6, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singleton, Jr. et al. (2004/0019724) in view of Ramakesavan (2003/0065734) and Duquette (6,667,877).

10. For claim 1, Singleton teaches a method (abstract; Paras. 1-11, 34-35) comprising:

- a. determining whether data meets a criteria (Paras. 24-27, 31-33);
- b. if the data does not meet the criteria, sending the data to a computer display of a computer (Paras. 24-27, 31-33), wherein the computer comprises a base portion and a lid portion, wherein the base portion and the lid portion of the computer are attached via a first hinge, wherein the base portion and the lid portion of the computer rotate via the first hinge between a first closed position and a first open position, and wherein the lid portion comprises the computer display (Paras. 11-16, 19-21); and
- c. if the data meets the criteria, sending the data to a personal digital assistant (Paras. 24-27, 31-33) attached to the laptop (Paras. 11-16, 19-21), wherein in the second open position a screen of the personal digital assistant is viewable simultaneously with the computer display when the base portion and the lid portion of the computer are in the first open position, and wherein in the second closed position the screen of the personal digital assistant is not viewable simultaneously with the computer display (Fig. 1).

11. Singleton does not expressly disclose that the PDA shifts between a second closed position atop the lid portion of the computer and an a second open position side-by-side with the lid portion of the computer. Ramakesavan teaches a method (abstract) of connecting (Paras. 1-24; 39-40) a PDA to a laptop (Figs. 4-7) wherein the PDA may be placed side by side with the monitor or otherwise shifted into the lid (Paras. 32-34). At the time the invention was made, one of ordinary skill in the art would have added Ramakesvan to Singleton in order to speed up the synchronization process (Para. 6)

12. Singleton does not expressly disclose that the PDA is detachably and rotatably connected to the lid portion of the computer via a second hinge, wherein the personal digital assistant rotates via the second hinge between the open and closed positions. Duquette teaches a method (abstract) of adding a synchronized device as a secondary display (col. 1, line 1 - col. 5, line 5; col. 6, lines 15 - 25) wherein the secondary system is detachably and rotatably connected to the laptop lid via a hinge such that it may rotate side by side or atop the lid (col. 5, line 5 - col. 6, line 15). At the time the invention was made, one of ordinary skill would have added Duquette to Singleton in order to provide better storage for PDA monitors (col. 4, lines 5 - 50).

13.

14. For claim 4, Singleton teaches determining whether the data comprises a calendar application window (Para. 18).

15. For claim 6, Singleton teaches determining whether the data comprises an e-mail application window (Para. 18).

16. For claim 23, Singleton does not expressly disclose sending input from an input device in the base portion to the personal digital assistant. Ramakesavan teaches integrating the laptop and PDA (Paras. 23 – 26) such that inputs from the laptop are sent to the PDA (Paras. 27 – 36).

17. Claims 2, 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Singleton, Ramakesavan and Duquette as applied to claim 1 above, and further in view of Chen et al. (2004/0148419).

18. For claim 2, Singleton does not expressly disclose determining whether the data comprises an instant messaging application window. Chen teaches the usage of IM applications (Paras. 81, 110, 191). At the time the invention was made, one of ordinary skill in the art would have added Chen to Singleton in order to improve the functionality of the PDA devices (Paras. 9 – 13).

19. For claim 5, Singleton does not expressly disclose determining whether the data comprises a media player application window. Chen teaches this limitation as well (Paras. 81, 110, 191).

20. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Singleton, Ramakesavan and Duquette as applied to claim 1 above, and further in view of Hawkins et al. (6,957,397).

21. For claim 3, Singleton does not expressly disclose determining whether the data comprises a calculator application window. Hawkins teaches the usage of calendar information

(col. 3, lines 15 – 25). At the time the invention was made, one of ordinary skill in the art would have added Hawkins to improve PDA functionality (col. 1, lines 40 – 65).

22. Claims 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Singleton, Ramakesavan and Duquette as applied to claim 1 above, and further in view of Huber et al. (7,197,584).

23. For claim 21, Singleton does not expressly disclose instructing a power supply of the computer to supply power to an input device of the computer, and receiving input at the personal digital assistant from the input device of the computer. Huber teaches a method (abstract) of attaching a PDA to a laptop lid (Fig. 6; col. 3, line 50 – col. 4, line 45) wherein a laptop's input device (keyboard) is tied to the power supply and wherein the PDA is controlled by the laptop (Fig. 5; col. 4, line 45 – col. 5, line 45). At the time the invention was made, one of ordinary skill in the art would have made the combination for power management purposes (col. 2, lines 30 -55).

24. For claim 22, Singleton does not expressly disclose determining that data has been changed at the personal digital assistant, determining whether the computer is powered on, and if the data has been changed at the personal digital assistant and the computer is powered on, synchronizing the data with the computer. Huber teaches this limitation (Fig. 5; col. 4, line 45 – col. 5, line 45; coordinated memory).

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELVIN H. POLLACK whose telephone number is (571)272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. H. P./
Examiner, Art Unit 2445
09 March 2009

/Larry D Donaghue/
Primary Examiner, Art Unit 2454